

REMARKS/ARGUMENTS

In the Advisory Action mailed July 7, 2005, the Examiner states that new issues arise from the changes made to amended claim 8 from the Amendment which was filed on June 28, 2005, recited in new limitations in claim 8, lines 9-10. Applicant thanks Examiner for the telephonic interview conducted with Applicant's undersigned representative on July 13, 2005, where Examiner indicated that the amendment to claim 8 by paper filed June 28, 2005 would be responsive to all issues raised in the final Office Action mailed March 29, 2005, but may raise new issues (as stated in the Advisory Action mailed July 7, 2005) which could be properly addressed by the filing of a Request for Continued Examination (RCE) in the application. Applicant accordingly files this amendment and supporting remarks as a submission required for a proper RCE under 37 CFR § 1.114, and as a reply under the requirements of 37 CFR § 1.111 to the final Office Action mailed March 29, 2005. Applicant hereby expressly requests that the present amendment and remarks be entered as the reply to the final Office Action mailed March 29, 2005, and that the previous after final amendment and remarks filed June 28, 2005 not be entered.

Accordingly, Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application and amendment is respectfully requested.

In the Final Office Action mailed March 29, 2005, claims 1-7 were allowed and Claim 8 was rejected. Applicant has thoroughly reviewed the outstanding Office Action including the Examiner's remarks and the references cited therein. The following remarks are believed to be fully responsive to the Final Office Action. All the pending claims at issue are believed to be patentable.

Claim 8 is presently amended. No claims are cancelled. No claims are added. As such, claims 1-8 remain pending.

Applicant notes that the present application, being a reissue application, requires that any amendment to the claims be made *vis à vis* the patent to be reissued. As such, currently amended claim 8 is presented with all words underlined, since claim 8 is a new claim relative to the patent to be issued. For clarity, and in accordance with the suggestions regarding "*Amendment of New Claims*" recited in MPEP Section 1453, Applicant herein sets forth the current changes to amended claim 8, relative to the last amendment entered in the application (with deletions in brackets and additions underlined):

8. **(Currently Amended)** A convertible rongeur comprising
a front handle piece;
a bottom shaft piece moveably attached to said front handle piece, said bottom shaft piece
having a tip portion and a handle portion and a longitudinal axis from said handle
portion to said tip portion said front handle piece being compressed toward said handle
portion of said bottom shaft piece to operate said rongeur; and
a top shaft cutting piece slideably engaged, along said longitudinal axis, with said tip portion
of said bottom shaft piece, wherein said top shaft cutting piece [being] is disengageable
[with said tip portion and] from said bottom shaft piece such that the top shaft cutting
piece no longer touches said bottom shaft piece but remains linked to said rongeur;
[wherein, when said top shaft cutting piece is disengaged from said tip portion and said bottom
shaft piece, said top shaft cutting piece remains attached to said rongeur so as to retain all
parts of said rongeur in one attached unit].

CLAIM REJECTION – 35 U.S.C. § 112

In the final Office Action, Claim 8 is rejected under 35 U.S.C. § 251 as being based on new matter added to the patent for which reissue is sought. Specifically, the Final Office Action states that in claim 8, the limitations “disengageable with said...bottom shaft piece” in lines 8-9 and “disengaged from said...said bottom shaft piece” in lines 10-11 have no basis in the original disclosure. The Final Office action explains that the rationale behind the rejection is that “even when the top shaft cutting piece 201 is in the position shown in FIG. 3, it is still attached to the bottom shaft piece 202 by attachment means such as link 223 and is therefore not disengaged from it.”

Applicants respectfully disagree with Examiner’s interpretation of claim 8. It appears that Examiner is interpreting the bottom shaft piece element to include the link 223. As shown in FIGS. 3 and 4A-D, the link 223 is a separate and distinct element from bottom shaft piece 202. It is a “link” because it serves as a separate linkage element between two pieces, one of which is the top shaft piece, the other being the bottom shaft piece. Yet, to recognize Examiner’s concern in the Final Office Action, and to make the claim more clear, Applicants have herein amended claim 8 to recite that “said top shaft cutting piece is disengageable from said bottom shaft piece such that the top shaft cutting piece no longer touches said bottom shaft piece but remains linked to said rongeur.” Thus, the top shaft piece 201 can be disengaged *in a particular manner* from the bottom shaft piece 202, as stated and described in the claim. When disengaged, the top shaft piece no longer touches the bottom shaft piece, but still remains attached to the rongeur overall, via a link, such as, in one preferred embodiment, link element 223. Thus, Claim 8, as amended, claims that the shaft pieces are disengageable from each other, not that the top shaft piece is

disengageable from the rongeur overall. As clearly stated in amended Claim 8, the top shaft piece “remains linked to said rongeur.”

Applicants also point out that the present amendment to Claim 8 is not improperly broadening the scope of the claim because the present scope is essentially the same as the claim was presented prior to the Final Office Action, namely, that the “top shaft cutting piece remains attached to said rongeur so as to retain all parts of said rongeur in one attached unit.” Applicants have merely reworded the claim to remove ambiguities and make the claim clearer and more definite, in line with Examiner’s suggestions as discussed below.

Applicants therefore respectfully assert that no new matter has been added to the patent for which reissue is sought, as all elements recited in claim 8, as amended, are properly disclosed in the original patent.

CLAIM REJECTION – 35 U.S.C. § 112

Claim 8 is rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Claim 8 has been amended to more clearly define what Applicant regards as the invention. Based on the reasons set forth above, Applicants believe that claim 8, which recites a “top shaft cutting piece [which] is disengageable from said bottom shaft piece such that the top shaft cutting piece no longer touches said bottom shaft piece but remains linked to said rongeur” has adequate basis and is sufficiently described in the patent, as shown in FIGS. 3 and 4D.

CLAIM REJECTION – 35 U.S.C. § 112

Claim 8 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With respect to claim 8, the Final Office Action states that inclusion of the limitation “tip portion and said bottom shaft piece” in line 9 of claim 8 is unclear and makes no sense. As explained above, Applicants have eliminated said limitation to make the claim more clear and meet the Examiner’s suggestion. Accordingly, Applicants believe the claim is definite.

In view of the foregoing arguments, Applicant respectfully requests that the rejections under 35 U.S.C. § 112 be removed.

CLAIM REJECTION – 35 U.S.C. § 102(a) or § 103(a)

Claim 8 is rejected under 35 U.S.C. § 102(a) as being anticipated by, or, in the alternative, under 35 U.S.C. § 103(a) as obvious over, Applicant’s disclosure. The Final Office Action stated that FIG. 1A, being admitted prior art, showed the top shaft cutting piece as being disengaged from the tip portion of the bottom shaft piece. Applicants assert that the rejection is no longer necessary because of the present form of amended claim 8, which simply recites that the top shaft piece is disengageable from the entirety of the bottom shaft piece, “such that the top shaft cutting piece no longer touches said bottom shaft piece but remains linked to said rongeur.” Such a configuration is not disclosed in the prior art FIGS. 1A-D disclosed in the patent.

Accordingly, Applicant respectfully submits that claim 8 is allowable.

Docket No. 59474.21501
Application No. 09/627,018
Customer No. 30734

Patent

In the event this paper is not timely filed, Applicant petitions for an appropriate extension of time. Please charge any fee deficiencies or credit any overpayments to Deposit Account No. 50-2036 with reference to Attorney Docket No. 59474.21501.

Respectfully submitted,

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